



11-15-02

GP1634
#

AMENDMENT TRANSMITTAL LETTER			DOCKET NUMBER: P-RD 4806	
SERIAL NO: 09/882,274	FILING DATE: June 15, 2001	EXAMINER: Lu, Frank Wei Min	GROUP ART UNIT: 1634	
INVENTION: USE OF PHOSPHOROTHIOLATE POLYNUCLEOTIDES IN LITIGATING NUCLEIC ACIDS				

TO COMMISSIONER FOR PATENTS

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Transmitted herewith is a Response to Office Action, mailed August 13, 2002, in the above-identified application.

- ☐ Small Entity status of this application has been established under 37 CFR 1.27.
- ☒ Petition for a two-month Extension of Time is enclosed (in duplicate).
- ☐ Terminal Disclaimer with fee under 37 C.F.R. 1.20(d) is enclosed.
- ☒ No additional claims fee is required.
- ☐ An additional claims fee is required and has been calculated as shown below:

CLAIMS AS AMENDED

CLAIMS TO AMENDED

	NUMBER AFTER AMEND- MENT		HIGHEST NUMBER PREVIOUSLY PAID FOR		NUMBER OF EXTRA CLAIMS PRESENTED		RATE			FEE	
							SMALL ENTITY	OTHER ENTITY		SMALL ENTITY	OTHER ENTITY
TOTAL CLAIMS	56	-	56	-	0	x	\$9	\$18	=	\$	\$0
INDEPEN- DENT CLAIMS	10	-	10	-	0	x	\$42	\$84	=	\$	\$0
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM			____ YES		____ X ____ NO		\$140	\$280	=	\$	\$0
							TOTAL ADDITIONAL FEE			\$	\$0

- * If the "HIGHEST NUMBER PREVIOUSLY PAID FOR" is less than 20, write "20" in this space.
 - ** If the "HIGHEST NUMBER PREVIOUSLY PAID FOR" is less than 3, write "3" in this space.
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- X A check in the amount of \$400.00 is enclosed, which covers the fee for a two-month extension of time.
- X The Commissioner is hereby authorized to charge payment of any fees associated with this communication or credit any overpayment to Deposit Account No. 03-0370. A duplicate copy of this sheet is enclosed.
- X The Commissioner is hereby authorized to charge to Deposit Account No. 03-0370 any fees under 37 CFR 1.17 which may be required under 37 CFR 1.136(a)(3) for an extension of time in any concurrent or future reply requiring a petition for extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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PATENT

Our Docket: P-RD 4806

HP/elec.
SP
11/19/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
Burgin and Stewart)
Serial No: 09/882,274)
Filed: June 15, 2001)
For: USE OF)
PHOSPHOROTHIOLATE)
POLYNUCLEOTIDES IN)
LIGATING NUCLEIC ACIDS)

Confirmation No: 7878
Group Art Unit: 1634
Examiner: Lu, Frank Wei Min

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Commissioner for Patents
Washington, D.C. 20231

Susan Faye L. Francisco
(TYPED OR PRINTED NAME OF PERSON MAILING PAPER OR FEE)
Susan Faye L. Francisco
(SIGNATURE OF PERSON MAILING PAPER OR FEE)

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS

Responsive to the Office Action mailed August 13, 2002,
entry of the following remarks is respectfully requested.

REMARKS

Claims 1-56 are pending, and are subject to a
restriction requirement under 35 U.S.C. § 121. The claims have
been restricted into four groups, as follows:

Group I: Claims 1 to 16, directed to a method of
non-enzymatic ligation of a nucleic acid (claims 1 to 7) and a
method of molecular cloning (claims 8 to 16);

Group II: Claims 17 to 28 and 52 to 55, directed to a
kit (claims 17 to 28) and a compound, (claims 52 to 55);

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Group III: Claims 29 to 35, directed to a method of ligating a nucleic acid; and

Group IV: Claims 36 to 51 and 56, directed to a kit (claims 36 to 43), a composition (claims 44 to 51) and a compound (claim 56).

Applicants traverse the restriction requirement for the reasons stated below. Nevertheless, in order to be responsive to the Office Action, Applicants elect the claims of Group I, claims 1 to 16, directed to a method of non-enzymatic ligation of a nucleic acid (claims 1 to 7) and a method of molecular cloning (claims 8 to 16). Applicants reserve the right to pursue prosecution of the non-elected claims in a later filed application claiming the benefit of priority of the above-identified Application.

The restriction requirement, sequence election requirement and species election requirements are traversed because examination of the claims of Groups I to IV together would not pose an undue burden on the Examiner.

In particular, the restriction requirement is traversed with respect to the division of the method claims of Group I from the composition claims of Group II. While the claims of Groups I and II are patentably distinct, it is submitted that a thorough search of the elected method claims of Group I will reveal art relevant to the examination of the composition claims of

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Group II. Specifically, claims of Group I are directed to methods for non-enzymatic ligation of a nucleic acid that employ a polynucleotide-3' phosphorothiolate, while the claims of Group II are directed to compositions containing a polynucleotide-3' phosphorothiolate. A search of a method of using a polynucleotide-3' phosphorothiolate in a non-enzymatic ligation of a nucleic acid will, of necessity, reveal information relevant to the examination of a composition containing a polynucleotide-3' phosphorothiolate. Therefore, division of the claims of Groups I and II would result in duplicative searches. For this reason, examination of the claims of elected Group I together with the claims of Groups II would not pose an undue burden on the Examiner.

Applicants respectfully submit that the Sequence Election Requirement set forth on page 4 of the Office Action mailed August 13, 2002, is improper. In this regard, Applicants point out that claims 36 and 44 exclude, rather than claim, the recited sequences.

CONCLUSION

Applicants elect with traverse the claims of Group I, claims 1-16, for examination. Applicants respectfully request that the restriction requirement be reconsidered and that the method claims of elected Group I be examined together with the composition claims of Group II. The Examiner is invited to call

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the undersigned agent or Cathryn Campbell if there are any questions regarding this application.

Respectfully submitted,

November 13, 2002
Date

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